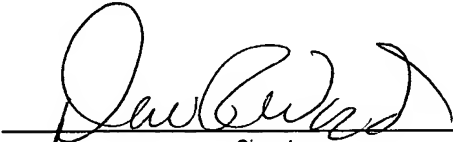




Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)  
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 101-1025	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/826,278	Filed  April 19, 2004	
	First Named Inventor  Joon-hyun YANG		
	Art Unit  2629	Examiner  Abbas Abdulsalam	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the  <input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number 53,868  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature  David R. Wood Typed or printed name  202-775-1900 Telephone number  February 19, 2008 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

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Remarks in Support of Pre-Appeal Conference Request

### **REMARKS/ARGUMENTS**

The Examiner has issued an Advisory Action dated February 8, 2008, in which the Examiner indicates that Applicant's Request for Reconsideration does not place the application in condition for allowance for the reasons given in the Final Office Action of October 16, 2007. It is to be noted that the above-referenced Advisory Action is the second that was issued; the first Advisory Action, dated February 4, 2008 indicated that Applicant's remarks in its Response of January 8, 2008 would not be entered. Applicant's representative contacted the Examiner on February 6, 2008, who appeared to be confused on the correct procedures for maintaining a complete and accurate record after final rejection<sup>1</sup>. Applicant requests that the record correctly reflect that no amendments were made in the Response of January 8, 2008.

Applicant requested in the Response after Final Rejection filed on January 8, 2008, (hereinafter, "the Response") that the finality of the Office Action of October 16, 2007 (hereinafter, "the Final Action") be withdrawn given the Examiner's improper reliance on the Kenji reference. The Examiner did not respond to the arguments presented in the Response, and instead issued the above-referenced Advisory Action. Nevertheless, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §103(a) in view of Schermerhorn as modified by Kenji are improper for at least the following reasons:

1. The suggested modification to the apparatus described in the primarily-cited Schermerhorn apparatus by the teachings of the secondarily-cited Kenji reference can only be substantiated by the full text of Kenji, an English translation of which has not been provided despite Applicant's request for such.

2. The Examiner's motivation to combine reference teachings is presented as a mere conclusory statement, and no line of reasoning has been provided as to how the suggested modification would be achieved so that the alleged benefits in Kenji would be inherited by the combination of Schermerhorn and Kenji.

3. There is a clear possibility that the full English translation of Kenji will reveal descriptive passages that teach away from the combination of Schermerhorn and Kenji, and the Examiner must provide the translation or withdraw the rejection.

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<sup>1</sup> Even now, the Examiner has indicated in item 7 of the "corrected" Advisory Action that amendments were made in the Reply filed on January 8, 2008, which is incorrect.

I. MODIFICATION REQUIRES FULL ENGLISH TRANSLATION OF KENJI

In the Response, Applicant reminded the Examiner of MPEP § 706.02, which provides that when an abstract is used to support a rejection, the evidence relied upon is the facts contained in the abstract, not additional facts that may be contained in the underlying full text document. The underlying document must be used to support a rejection if not all of the evidence required for a *prima facie* showing of obviousness is disclosed in the abstract. Additionally, MPEP § 706.02 provides that even if the abstract alone appears to support a rejection, which is not the case here as described further below, the full text document may include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103. Thus, in addition to the deficiencies of the abstract of Kenji, Applicant has been denied any opportunity to rebut the Examiner's allegations by way of disclosure adverse to the Examiner's position that may be contained in the full text of the reference.

In the Advisory Action of February 8, 2008, (hereinafter, "the Advisory Action"), the Examiner states that, "the abstract [of Kenji] has enough information to teach the missing limitation in Schermerthorn [sic]." See Advisory Action, continuation sheet, lines 4-5. Despite Applicant's reminders, the Examiner has not provided an English translation of Kenji, and currently does not provide any explanation as to what information in the abstract of Kenji is "enough." Moreover, it is respectfully submitted that the abstract of Kenji alone is insufficient to show *prima facie* obviousness for at least the reason that mere disclosure of a "missing limitation," does not provide the implementation details necessary to achieve the alleged benefits in other contexts. This is especially true in the present case, where the alleged feature, the direct connection allegedly disclosed in Kenji, resides in the midst of complex circuitry.

In the Final Action, the Examiner cites the reduction of electromagnetic radiation as motivation to combine reference teachings, and, according to the abstract of Kenji, the reduction in radiation is achieved through a reduction in a current peak by way of timing the applied voltages on terminals connected to discharge electrodes. This timing is essential to achieve the benefits of Kenji, i.e., the reduction of electromagnetic radiation, but is not disclosed in detail in the abstract. Consequently, modifying the teachings of Schermerhorn, which is a single-ended driver, by Kenji, which is not a single-ended driver, to inherit the purported benefits thereof, if at all possible, requires at least knowledge that can only be gleaned from the full text of both

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references. Accordingly, it is respectfully submitted that the full English translation of Kenji must be provided, or the rejections relying thereon must be withdrawn.

II. LINE OF REASONING REQUIRED TO COMBINE REFERENCE TEACHINGS

In the Final Action, the Examiner takes the position that modification of Schermerhorn by Kenji would have been obvious, "because the use of the first switchable current path z1 and the second current path z2 helps reduce unnecessary electromagnetic radiation." See Final Action, pages 4, 6, and 8. In the Response, Applicant reminded the Examiner of MPEP § 2143, which states, in part, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In the Final Action, the Examiner merely states a conclusion and neither explains any reasoning behind that conclusion nor provides explicit analysis of how such a conclusion was reached. The Examiner repeats the conclusory statement in the Advisory Action. However, it is respectfully submitted that the abstract of Kenji simply does not provide any detail as to, for example, how the timing of its generated voltage waveforms are achieved, and how the impedance differences between current paths are established, and the Examiner has made no attempt to elaborate, even when it was requested that he do so. Additionally, the Examiner has not explained how the internal electrode model of Schermerhorn is to be replaced by the direct connection allegedly disclosed in Kenji without changing the operating principles of Schermerhorn, as Applicant pointed out in the Response. These implementation details must be clear, since Schermerhorn's resonance requirements rely on the electrode model disclosed therein, and replacing the modeled circuitry in Schermerhorn with the direct connection allegedly disclosed in Kenji is not a matter of simply implementing the direct connection. Schermerhorn relies on a resonant peak in current, and Kenji seeks to decrease a peak in current, which is a clear indication that simply implementing the direct connection in Schermerhorn would likely render the circuit therein inoperative. Thus, it is apparent that not only is the full text document of Kenji required to support *prima facie* obviousness, the reasoning underlying as to how the benefits of Kenji are achieved in Schermerhorn in light of contradicting current requirements of the reference teachings must also be provided. For at least this reason,

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the full English translation of Kenji should be entered into the record, and a detailed analysis supporting the Examiner's suggested modification be provided, or the rejections based thereon should be withdrawn.

III. LIKELIHOOD OF TEACHING AWAY FROM COMBINATION

Applicant has maintained since its Response of August 1, 2007 that the Examiner's proposed modification of Schermerhorn by Kenji cannot be achieved without violating a designed operating principle of Schermerhorn. Additionally, Applicant repeatedly reminded the Examiner that, in view of In re Ratti, a modification that changes the principle of operation of the prior art invention being modified is evidence that the teachings of the references are not sufficient to render the claims *prima facie* obvious. The Examiner has yet to address this issue. Nevertheless, Applicant is confident that, if provided with the full English translation of Kenji, its position can be corroborated by the reference teachings. Applicant's confidence is derived from its belief that an ordinarily skilled artisan would not have attempted to modify Schermerhorn with Kenji, given the fundamentally different operating principles of the systems disclosed in the respective references. Accordingly, it is respectfully submitted that the rejections of the pending claims that rely on Kenji are improper, and the translation of the full text of Kenji is likely to substantiate such.

IV. CONCLUSION

In the Response, Applicant reminded the Examiner that "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). It is respectfully submitted that Schermerhorn and the abstract of Kenji, separately and combined, do not provide enough implementation detail to expressly or impliedly suggest Applicant's claimed invention, and, absent such, the Examiner has not presented a clear line of reasoning as to why the claimed invention would have been found obvious to the

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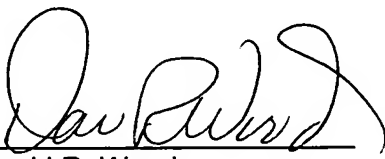
skilled artisan.

In light of the foregoing remarks, it is respectfully requested that the pending claims of the subject Patent Application be allowed, or that the full English translation of Kenji be provided along with clear reasoning based thereon explaining how the contradictory operating principles in both references can be overlooked.

Respectfully submitted,

STANZIONE & KIM, LLP

Dated: February 19, 2008  
919 18<sup>th</sup> St., NW, Suite 440  
Washington, DC 20006  
Telephone: (202) 775-1900  
Facsimile: (202) 775-1901

By:   
David R. Wood  
Registration No. 53,868